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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application. No. : 10/611,326

1st Named Inventor: William W. Macy

Filed : June 30, 2003

Docket No. : 42P15770

Confirmation No.: 3731

Art Unit : 2155

Examiner : David Y. Eng

Customer No. : 8791

Commissioner for Patents PO Box 1450 Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Dear Sir:

In accordance with the duty of disclosure, enclosed is a copy of Information Disclosure Statement (IDS) by Applicant (form PTO/SB/08), together with copies of the documents cited on that form, except for copies not required to be submitted (e.g., copies of U.S. Patents and U.S. published patent applications need not be enclosed). This IDS is being submitted before the mailing of a final Office Action. It is respectfully requested that the cited references be considered and that the enclosed copy of PTO/SB08 be initialed by the Examiner to indicate such consideration and a copy thereof returned to applicants. Some or all of the references listed on the enclosed PTO/SB/08 were previously identified in the parent application (Application No. 09/053,401 filed March 31, 1998) and copies of the references were furnished at that time. Accordingly, per 37 CFR §1.98(d)(1) additional copies of those references may not necessarily be submitted herewith.

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The submission of this Information Disclosure Statement is not to be construed as a representation that a search has been made in the subject application and is not to be construed as an admission that the information cited in this statement is material to patentability.

Please charge the fee in the amount of \$180 for submission of the Information Disclosure Statement to Deposit Account 02-2666. A duplicate copy of the Fee Transmittal (PTO/SB/17) is enclosed for this purpose.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

1279 Oakmead Parkway Sunnyvale, California 94085 (303) 740-1980

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)

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Complete if Known **FEE TRANSMITTAL** Application Number 10/611,326 for FY 2006 Filing Date June 30, 2003 First Named Inventor William W. Macy Examiner Name David Y. Eng Applicant claims small entity status. See 37 CFR 1,27. Art Unit 2155 TOTAL AMOUNT OF PAYMENT (\$) 180.00 Attorney Docket No. 42P15770 METHOD OF PAYMENT (check all that apply) ☐Check ☐Credit card ☐ Money Order ☐None Other (please identify): Deposit Account Deposit Account Number: 02-2666 Deposit Account Name: Blakely, Sokoloff, Taylor & Zafman LLP For the above-identified deposit account, the Director is hereby authorized to: (check all that apply) ☑ Charge fee(s) indicated below Charge fee(s) indicated below, except for the filing fee Charge any additional fee(s) or underpayment of fee(s) ☑ Credit any overpayments under 37 CFR §§ 1.16, 1.17, 1.18 and 1.20. **FEE CALCULATION** Large Entity Small Entity Fee Fee Fee Fee Fee Description Fee Paid Code Code (\$) (\$) 1051 130 2051 65 Surcharge - late filing fee or oath 1052 50 2052 ²⁵ Surcharge - late provisional filing fee or cover sheet. 2053 130 2053 130 Non-English specification 1251 120 2251 60 Extension for reply within first month 1252 450 2252 225 Extension for reply within second month 1253 1,020 2253 510 Extension for reply within third month 1254 1,590 2254 795 Extension for reply within fourth month 1255 2255 2,160 1,080 Extension for reply within fifth month 1401 500 2401 ²⁵⁰ Notice of Appeal 1402 500 2402 ²⁵⁰ Filing a brief in support of an appeal 1403 1.000 2403 500 Request for oral hearing 1451 1,510 2451 1,510 Petition to institute a public use proceeding 1460 130 2460 130 Petitions to the Commissioner 1807 1807 50 ⁵⁰ Processing fee under 37 CFR 1.17(a) 1806 180 1806 180 Submission of Information Disclosure Stmt 180.00 1809 790 1809 395 Filing a submission after final rejection (37 CFR § 1.129(a)) 1810 790 2810 395 For each additional invention to be examined (37 CFR § 1.129(b)) Other fee (specify) SUBTOTAL (2) 180.00 SUBMITTED BY Complete (if applicable) Registration No. Name (Print/Type) Daniel M. DeVos 37.813 Telephone (408).720-8300 (Attorney/Agent) ′いつ Signature Date



	 		
TRANSMITTAL F	ORM	Application No.	10/611,326
		Filing Date	June 30, 2003
(to be used for all correspondence after	er initiai tiling)	First Named Inventor	William W. Macy
		Art Unit	2155
		Examiner Name	David Y. Eng
Total Number of Pages in This Submission	n 15	Attorney Docket Number	42P15770
ENCLO	SURES (chec	k all that apply)	
Fee Transmittal Form	Drawing(s)		After Allowance Communication to TC
Fee Attached	Licensing-r	elated Papers	Appeal Communication to Board of Appeals and Interferences
Amendment / Reply	Petition		Appeal Communication to TC (Appeal Notice, Brief, Repty Brief)
After Final Affidavits/declaration(s)	Petition to 0 Provisional	Convert a Application	Proprietary Information
Extension of Time Request	Power of A Change of	ttorney, Revocation Correspondence Address	Status Letter
Express Abandonment Request	Terminal Di	sclaimer	Other Enclosure(s) (please identify below):
Information Disclosure Statement	Request for	Refund	Notice of Other Patents and Patent Applications &
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Response to Missing Parts under 37 CFR 1.52 or 1.53			
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Firm Daniel M. De Vo	os, Reg. No. 37	,813	
	OKOLOFF, T	AYLOR & ZAFM	AN LLP
Signature			
Date 7/20/0	7		
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I hereby certify that this correspondence is be sufficient postage as first class mail in an env 22313-1450.	ing deposited with elope addressed to	the United States Postal So: Commissioner for Pater	Service on the date shown below with its, P.O. Box 1450, Alexandria, VA
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JUL 2 3 2007 Docket No: 42P15770
IN THE UNITED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.

: 10/611,326

First Named

William W. Macy

Inventor

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TC/A.U.

Examiner
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: David Y. Eng : 42P15770

: 45209

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

NOTIFICATION OF RELATED LITIGATION UNDER MPEP § 2001.06 (C)

Examiner:

U.S. Patent No. 6,418,529 ("the '529 patent") is involved in the litigation Transmeta Corporation v. Intel Corporation, which has been assigned docket case number 1:06cv633. The above-captioned case (U.S. Patent Appl. No. 10/611,326) claims priority to the '529 patent. To this point, documents including a COMPLAINT¹, a FIRST AMENDED COMPLAINT², INTEL CORPORATION'S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS TO TRANSMETA'S FIRST AMENDED COMPLAINT³ ("Answer"), TRANSMETA CORPORATION'S REPLY TO INTEL CORPORATION'S COUNTERCLAIMS TO THE FIRST AMENDED COMPLAINT⁴ ("Reply"), and TRANSMETA CORPORATION'S RESPONSES TO INTEL

¹ Listed on the accompanying Information Disclosure Statement (IDS) as: COMPLAINT, In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, dated October 11, 2006, pages 1-7.

² Listed on the accompanying IDS as: FIRST AMENDED COMPLAINT, In the United States District Court for the District of Delaware, <u>In the matter of Transmeta Corporation v. Intel Corporation</u>, C.A. No. 06-663 (GMS), dated December 12, 2006, pages 1-8.

³ Listed on the accompanying IDS as: INTEL CORPORATION'S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS TO TRANSMETA'S FIRST AMENDED COMPLAINT, In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, Civil Action No. 06-663-GMS, dated January 9, 2007, pages 1-27.

⁴ Listed on the accompanying IDS as: TRANSMETA CORPORATION'S REPLY TO INTEL CORPORATION'S COUNTERCLAIMS TO THE FIRST AMENDED COMPLAINT, In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation,, dated February 28, 2007, pages 1-20.

CORPORATION'S FIRST SET OF INTERROGATORIES (NOS. 1-20)⁵ ("Transmeta's Responses to Intel's First Interrogatories"), have been filed in the suit. A brief description of some of these documents as they pertain to the '529 patent is provided below.

In paragraph's 88-93 of Intel's Answer there is a counterclaim regarding patent infringement of the '529 patent.

First, in paragraph 96 of Transmeta's Reply, there is an allegation that the '529 patent "is invalid for failure to comply with Title 35 of the United States Code, including without limitation Sections 102, 103, and/or 112".

Response to Interrogatory 13 of Transmeta's Responses to Intel's First Interrogatories identifies art that Transmeta contends "anticipate the '529 patent under 35 U.S.C. § 102 or render the '529 patent obvious under 35 U.S.C. § 103". See e.g., page 30. Art is also identified that Transmeta contends "at least demonstrate the state of the art of the '529 patent". See e.g., pages 31-34.

Response to Interrogatory 14 of Transmeta's Responses to Intel's First Interrogatories includes an allegation that "[o]ne or more claims of the '529 patent are invalid under 35 U.S.C. § 112 at least because certain claims are indefinite". See e.g., pages 36-37. In particular, it is alleged that "claim 26 of the '529 patent refers to 'completing execution of said single instruction by storing said second data element in a second field of the storage area". It is further alleged that "[t]he phrase 'completing execution' is incomprehensible in light of claim 25, which also includes a step of 'completing execution'" and that "[t]herefore, the requirements of 35 U.S.C. § 112 are not satisfied".

Second, in paragraphs 109-115 of Transmeta's Reply, there are allegations of "inequitable conduct and unenforceability" pertaining to the '529 patent. The allegations state that those "substantively involved in prosecuting the application leading to the '529 patent deliberately and knowingly withheld material information in connection with the prosecution of the application that matured into the '529 patent, in violation of the duty of candor to the USPTO and with intent to deceive the USPTO". The two pieces of

⁵ Listed on the accompanying IDS as: TRANSMETA CORPORATION'S RESPONSES TO INTEL CORPORATION'S FIRST SET OF INTERROGATORIES (NOS. 1-20), In the United States District

allegedly material information identified were WO97/08610, and "the Intel 8086/80186/80286/80386 microprocessor instruction set, and in particular the implementation by these microprocessors of an instruction (ADD AL, AH)". On page 30 of Transmeta's Responses to Intel's First Interrogatories, the list of references identified for the '529 patent includes the Intel 80386 Programmer's Reference Manual, 1986 as an apparent source of the 8086/80186/80286/80386 instruction set - ADD AL, AH instruction. Accordingly, WO97/08610 and the Intel 80386 Programmer's Reference Manual, 1986 are being submitted in the accompanying IDS.

Invitation for a telephone interview

The Examiner is invited to call the undersigned at (408) 720-8300 if there are any questions regarding this material.

Charge our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: $\frac{7/2^{\circ}}{2}$, 2007

Daniel M. DeVos, Reg. No. 37,813

12400 Wilshire Boulevard Seventh Floor Los Angeles, California 90025-1026 (408) 720-8300



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Appl. No.

: 10/611,326 · William W. Macy

First Named Inventor

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Examiner Docket No. : David Y. Eng : 42P15770

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: 45209

Commissioner for Patents

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Alexandria, Virginia 22313-1450

NOTICE OF OTHER PATENTS AND PATENT APPLICATIONS

Examiner:

Applicants want to put the Examiner on notice of the following other patents and patent applications with the same specification or disclosing related subject matter as the above-captioned application:

09/053,401 (Attorney Docket No. P4919), filed on March 31, 1998, now U.S. Patent No. 6,418,529.

10/193,645 (Attorney Docket No. P4919C), filed on July 9, 2002, now U.S. Patent No. 6,961,845. 10/193,645 is a continuation of 09/053,401, now U.S. Patent No. 6,418,529.

10/610,784 (Attorney Docket No. P15768), filed on June 30, 2003, currently pending. 10/610,784 is a continuation-in-part of 09/952,891, filed Oct. 29, 2001, now U.S. Patent No. 7,085,795. 10/610.784 is also a continuation-in-part of 10/193,645, now U.S. Patent No. 6,961,845. 10/193,645 is a continuation of 09/053,401, now U.S. Patent No. 6,418,529.

09/053,388 (Attorney Docket No. P5341), filed Mar. 31, 1998, now U.S. Pat. No. 6,212,618.

09/053,389 (Attorney Docket No. P4924), filed Mar. 31, 1998, now U.S. Pat. No. 6,211,892.

Invitation for a telephone interview

The Examiner is invited to call the undersigned at (408) 720-8300 if there are any questions regarding this material.

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Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: $\frac{7}{2}$, 2007

Daniel M. DeVos, Reg. No. 37,813

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Los Angeles, California 90025-1026 (408) 720-8300

Substitute for form 1449A/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Application Number	10/611,326	
Filing Date	June 30, 2003	
First Named Inventor	Macy, William	
Group Art Unit	2155	
Examiner Name Eng, David		

Sheet 1 of 5

			US PATE	NT DOCUMENTS	
Examiner Initial *	Cite No 1	USP Document Number	Publication or Issue Date MM-DD-YYYY	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
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		US-3,723,715	03/27/1973	Chen, Tien C., et al.	
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		US-4,189,716	02/19/1980	Krambeck, Robert H.	
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		US-4,498,177	02/05/1985	Larson, Brian R.	
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		US-5,095,457	03/10/1992	Jeong, Ho-Sun	
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		US-5,201,056	04/06/1993	Daniel, Samuel , et al.	
		US-5,327,369	07/05/1994	Ashkenazi, Yaron	· · · · · · · · · · · · · · · · · · ·
		US-5,339,447	08/16/1994	Balmer, Keith	······································
		US-5,390,135	02/14/1995	Lee, Ruby B., et al.	
		US-5,418,736	05/23/1995	Widigen, Larry, et al.	
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		US-5,721,697	02/24/1998	Lee, Ruby B.	
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		US-5,815,421	09/29/1998	Dulong, Carole , et al.	
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		US-5,822,232	10/13/1998	Dulong, Carole , et al.	
		US-5,859,790	01/12/1999	Sidwell, Nathan M.	

DATE CONSIDERED EXAMINER

Substitute for form 1449A/PTO	Complete if Known	
	Application Number	10/611,326
INFORMATION DISCLOSURE	Filing Date	June 30, 2003
STATEMENT BY APPLICANT	First Named Inventor	Macy, William
(Use as many sheets as necessary)	Group Art Unit	2155
	Examiner Name	Eng, David
Sheet 2 of 5	Attorney Docket No: 4	2P15770

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04/09/2002	Guttag, Karl, et al.
	02/23/1999 03/09/1999 03/09/1999 03/16/1999 03/23/1999 05/04/1999 11/09/1999 11/09/1999 12/21/1999 01/11/2000 01/11/2000 01/19/2000 03/21/2000 05/08/2001 05/08/2001

		FOR	EIGN PATEN	IT DOCUMENTS		
Examiner Initials*	Cite No 1	Foreign Patent Document Country Code/Number/Kind Code (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ²
		EP-0318957	06/07/1989	Kuroda, Koji , et al.		
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		WO-9723821	07/03/1997	Dulong, Carole , et al.		

	רס	THER DOCUMENTS NON PATENT LITERATURE DOCUMENTS	
Examiner Initials*	Cite No 1	include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		"COMPLAINT", In the United States District Court for the District of Delaware, In the matter of Transmeta v. Intel Corporation, (10/11/2006), 1-7	
		"FIRST AMENDED COMPLAINT", In the United States District Court for the District of Delaware, In the matter of Transmeta Corporation v. Intel Corporation, C.A. No, 06-663 (GMS), (12/12/2006), 1-8	

EXAMINER DATE CONSIDERED

Substitute for form 1449A/PTO	Complete if Known	
	Application Number	10/611,326
INFORMATION DISCLOSURE	Filing Date	June 30, 2003
STATEMENT BY APPLICANT	First Named Inventor	Macy, William
(Use as many sheets as necessary)	Group Art Unit	2155
	Examiner Name	Eng, David
Sheet 3 of 5	Attorney Docket No: 42P15770	

	"INTEL CORPORATION'S ANSWER, AFFIRMATIVE DEFENSES, AND	
	COUNTERCLAIMS TO TRANSMETA'S FIRST AMENDED COMPLAINT", In the	
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EXAMINER DATE CONSIDERED

Substitute for form 1449A/PTO	Complete if Known	
	Application Number	10/611,326
INFORMATION DISCLOSURE	Filing Date	June 30, 2003
STATEMENT BY APPLICANT	First Named Inventor	Macy, William
(Use as many sheets as necessary)	Group Art Unit	2155
	Examiner Name	Eng, David
Sheet 4 of 5	Attorney Docket No: 4	12P15770

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